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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,697	10/31/2001	Frank J. Kronzer	11301-0222 (44039-264309)	2526

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/003,697

Applicant(s)

KRONZER, FRANK J.

Examiner

Tamra L. Dicus

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Double Patenting***

1. Claims 1-30 of this application conflict with claims 1-32 of Application No. 10/003,698. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-30 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-32 of copending Application No. 10/003,698. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### **OBJECTION**

4. Applicant is advised that should claim 1 be found allowable, claim 22 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application

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are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-18, 21-26, and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,232,267 to Oshima et al.

7. Oshima teaches a thermal transfer sheet comprising a substrate of polypropylene, polyester films and processed paper (cellulosic nonwoven) (claims 12, 13, 17, 22, 26), a release coating layer, a white layer which may comprise a resin binder of fluoro carbon, melamine, polyurethane or silicone resins (cross-linkable binder) and an adhesive (opaque crosslinked polymer layer and/or discontinuous polymer layer having an opacifying material), a peeling film layer and a dye layer (discontinuous printable layer) adjacent to the adhesive layer. The peeling layer may also contain the white pigment (opacifying white pigment) (col. 5, lines 50-55). See col. 6, lines 1-35 and col. 8, lines 1-20. At col. 8, line 33, Oshima teaches cross-linking any of the aforementioned resins, and further describes how the white layer may include PMMA, cellulosic derivatives, an acrylic resin, an epoxy (cross-linking agent), an ethylene/acrylic acid

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copolymer and any copolymer combined materials of two or more (meeting claims 2-3, 5-7, 18, 21). See col. 8, lines 35-55 and Figures 1 and 2.

At col. 9, lines 33-65, Oshima teaches the peeling layer comprises polyethylene wax (claims 9, 14, 23).

Oshima teaches a receptor layer comprising a release layer. At col. 12, lines 1-15, Oshima teaches adding an additive such as a release agent like an epoxy or silicon modified agent, a reaction-curable silicon compound (curing agent). At col. 12, lines 25-40, a release layer also comprises a urethane or PVA resin. At col. 9, lines 50-68, a releasing agent such as a fluorocarbon resin, silicone wax, and a surfactant are included. Also acrylic or any combinations of polymers are taught at col. 10, lines 1-9. Claims 10, 11, 15, 16, 24 and 25 are met.

Processes for transferring the sheet of Oshima is taught at col. 10, lines 10-20 and in Example 1, Comparative Example 2, and col. 16. Also the substrate may be coated on either side with a polymer or coating liquid. See also col. 7, lines 1-45. Claims 28-30 are met.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 10, 21, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,232,267 to Oshima et al. in view of USPN 5,508,105 to Orensteen et al.

10. Oshima essentially teaches the claimed invention above. Oshima does not teach adding aziridine. However, Orensteen teaches a thermal print receptive and retroreflective sheeting

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where he teaches adding crosslinker aziridine (multifunctional aziridine) increases weatherability and chemical resistance, improves the tendency of a top layer to lie flat and low curing temperatures in such a multi-function layer. Hence it would have been obvious to one of ordinary skill in the art to modify the sheet of Oshima to further include aziridine in any layer since Orensteen teaches adding it provides many functions as taught above. See col. 9, lines 12-35.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,716,900 to Kronzer et al. teaches a heat transfer sheet having a nonwoven cellulosic paper containing titania, ethylene-acrylic, fluorocarbons, wax, PVC, and having release and peelable functions.

12. USPN 6,358,660 to Agler et al. teaches coated transfer sheets comprising UV material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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Tamra L. Dicus  
Examiner  
Art Unit 1774

March 24, 2003

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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